

REMARKS

Claims 1-6, 8-13, 15-20, 22 and 23 are pending in the application. Solely to advance prosecution of certain embodiments of the present invention that are considered at this time to be advantageous for business related purposes, Applicant has canceled claims 5, 12, and 19, and incorporated their features into claims 1, 8, and 15, respectively. Thus, amended claims 1, 8, and 15 are clearly distinguishable from the cited art. By this amendment, Applicant in no way acknowledges that claims 1, 8, and 15 are not patentable in and of themselves without the incorporation of the features of canceled claims 5, 12, and 19. In that respect, Applicant provides several reasons below to support this position. Accordingly, Applicant reserves the right to prosecute these broader embodiments in a continuing application.

Claim Rejections - 35 U.S.C. § 103

Claims 1-6, 8-13, 15-20 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fongeallaz in view of Filiczowski (5,106,098). As noted, Applicant has canceled claims 5, 12, and 19, and incorporated their features into independent claims 1, 8, and 15, respectively. Applicant respectfully requests allowance of the claims for the following reasons.

In Applicant's October 6, 2003 Amendment, the rejection of independent claims 1, 8 and 15, which define different aspects of the invention, was addressed in detail. It was noted that all three sets of independent claims contained common features, including (1) a racing field (a) formed on a predetermined board, and (b) having a plurality of tracks that are concurrently existing on the board, (2) the "tracks" being separate and distinct areas on the common racing field that have different characteristics, i.e., running environments (dirt or turf), and (3) the use of a "running model" that is a physical or electronic representation.

In the Amendment, Applicant presented four basic arguments, any one of which Applicant respectfully submits would rebut any *prima facie* basis for rejection and would support a patentable distinction of the claimed invention over the prior art, including:

- Fongeallaz et al does not teach a plurality of concurrently existing tracks;
- Fongeallaz et al is incompatible with plural concurrently existing tracks;

- Filiczkowski provides no relevant teaching for modification of Fongeallaz et al; and
- Neither Fongeallaz nor Filiczkowski provide any motivation for their combination.

As subsequently demonstrated, the Examiner's rebuttal of these arguments falls far short of demonstrating that the Applicant is not entitled to a patent on the invention as claimed. The flaws in the Examiner's position are clear, as subsequently detailed.

Fongeallaz et al does not teach plural concurrently existing tracks.

In the previous Amendment, Applicant argued that Fongeallaz teaches only a single track having individual lanes. Applicant stressed that the invention expressly requires "concurrently existing tracks." The term "concurrently existing" clearly means that two or more tracks exist on the racing field formed on the predetermined board at the same time. "Concurrently existing" can only mean appearance at the same time, not sequentially or at different times. A display of tracks at different times could not be "concurrently existing."

Applicant surmises that the Examiner appears to understand this distinction, since the Examiner admits in paragraph 5 that "Fongeallaz does not teach independent tracks." The Examiner comments that this is what the Examiner believes to be what Applicant is attempting to claim. However, Applicant respectfully notes that the Examiner's comment may explain a basic misunderstanding. The Applicant is not attempting to claim "independence," since tracks that appear at different points in time may be "independent" but would not be concurrently existing. Instead, Applicant is specifying that the tracks are "concurrently existing," that is appearing at the same time.

Thus, given the further explanation of this point, the Examiner must accept the limitation "plural concurrently existing tracks" as a basis for patentability.

The Examiner comments that Filiczkowski teaches two independent tracks. However, as already noted, Applicant is not claiming "independent tracks." Nonetheless, assuming arguendo, even if the Examiner takes the position that Filiczkowski teaches two "concurrently existing tracks", this position is not supported. As is clear from a review of the reference, without dispute

by the Examiner, the Filiczkowski tracks are static, painted or printed on a board. The description in Filiczkowski does not come with any teaching or suggestion as to how they may be applied to a computerized game. There is no teaching or suggestion as to how they may be presented on a display, whether the display is electronic, mechanical or electro-mechanical.

Fongeallaz et al is incompatible with plural concurrently existing tracks

The Examiner acknowledges in paragraph 6 that Applicant's position is that Fongeallaz is incompatible with plural concurrently existing tracks. The Examiner asserts that this is not the case because Fongeallaz teaches that any type of track can be simulated, including an all dirt track and an all grass track. Applicant respectfully believes that this comment demonstrates that the Examiner has misread the claim. The key is that there must be concurrently existing tracks in order to meet the features of the claimed invention. Applicant's point is that the physical and electronic arrangement in Fongeallaz is incompatible with a concurrent display of two tracks. Fongeallaz uses a primitive two-dimensional array. The focus of the game is on a single race. There is no teaching or suggestion as to how a race on one track may be displayed while a second unused track would also be displayed concurrently. Not only is there no concurrent display, such display would be highly undesirable, as it would present a serious detraction and a confusing arrangement in the Fongeallaz device.

In short, the basic arrangement of Fongeallaz teaches away from and would be incompatible with a key feature of the claimed invention. The Examiner has not addressed this issue, and, Applicant believes that it is a clear basis for patentability.

Filiczkowski provides no relevant teaching

In the previous Amendment, Applicant identified several reasons why Filiczkowski illustrates two tracks on a single board. Applicant also noted that Filiczkowski does not mention computerized games or other mechanical or electrical games. This is unchallenged.

One skilled in the art would not look to a board game for a teaching of how to implement a computerized game as claimed. If one skilled in the art were to implement a racing game, it would involve the presentation of one track at a time. As noted earlier, this is especially true where the display is electronic, as on a CRT or similar display.

The Examiner argues that “any number of board games has been transferred to computer.” This is a generic statement that does not address the manner in which the specifically claimed invention, having a racing field, plural concurrently existing tracks on the field and a running model having inherent ability parameters, may be derived from a board game such as taught in Filiczkowski. At best, one skilled in the art would display only one track at a time in any computerized implementation of Filiczkowski.

Neither Fongeallaz et al nor Filiczkowski provides any motivation

Applicant maintains that neither reference alone or in combination provides a basis for obviousness since there is no motivation for their combination, and as previously asserted, these references teach away from the present invention. In evaluating obviousness on the basis of a combination of multiple references, as required by MPEP §2143.01, the prior art must suggest the desirability of the claimed invention.

Fongeallaz clearly does not suggest concurrently existing tracks. It merely teaches a single track on a matrix display. Nothing in Fongeallaz suggests modifying the two dimensional display to present concurrently existing tracks. In fact, as already asserted, concurrently existing tracks would be a detriment to the display of Fongeallaz.

Filiczkowski similarly does not suggest the use or display of a plurality of concurrently existing tracks on a computerized game. There is no teaching of such implementation. The only suggestion that the Examiner can offer in support of his position is that many board games have been implemented by computers. Nonetheless, this does not deal with the difficult problem of presenting concurrently existing tracks. The technical and human interface challenges that exist in presenting a plurality of concurrently existing tracks on the basis of the teachings of the two references are overwhelming and mitigate against any *prima facie* case of obviousness.

On the technical side, the Examiner’s proposed modification would necessarily change the principle of operation of Fongeallaz since it would require a display of a race on the part of the two dimensional board while maintaining another portion of the board inert or unused. On the human interface side, this would make no sense from a practical point of view as it would detract from the enjoyment provided to the players and would by its nature leave a majority of the usable display surface under utilized for every race.

Applicant has successfully rebutted any *prima facie* case

In MPEP §2144.05, it is made clear that an Applicant can rebut even a *prima facie* case of obviousness by showing that the art, in any material respect, teaches away from the claimed invention, citing *In re Geisler*, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). MPEP §2145 notes that a prior art reference that teaches away from the claimed invention is a significant factor to be considered in determining obviousness. The nature of the teaching in Fongellaz is of a single board with a single track and a matrix-like display that has no compatibility with a concurrently multi-track display. Fongellaz clearly teaches away from a plurality of concurrently existing tracks.

The Examiner cited the case of *In re Keller*, 208 USPQ 871 (CCPA 1981) as supporting his position that the Applicant's arguments against the references individually are not a basis for showing unobviousness. However, the thrust of the Applicant's arguments are not against the references individually, but their combination. The Examiner has not demonstrated how and why and with what motivation one of ordinary skill would modify Fongellaz in a significant way to attempt to incorporate features of a printed board game on a matrix display device, where the combination is technically and practically undesirable. How and why this would be done without undue experimentation and the impermissible use of hindsight based upon Applicant's own teachings has not been addressed by the Examiner.

Finally, solely to advance prosecution of particular embodiments of the invention, Applicant has amended claims 1, 8, and 15 to incorporate the passageway feature previously recited in canceled claims 5, 12 and 19. The Examiner's assertion that the starting posts and finish lines are passageways is simply wrong. There is nothing in the reference that would enable these posts or lines to perform the functions of the passageways of the disclosed and claimed invention. The passageways permit movement of a running model from one track to another. To further define this feature, Applicant has defined the passageways such that the running model can enter and exit *between the tracks*. Clearly, this feature could not be suggested by the Examiner's starting posts and finish lines.

In short, the Applicant strongly believes that the invention as defined in the independent claims is clearly patentable over the references alone or in combination.

Dependent claims

Finally, Applicant has argued that the prior art fails to teach the limitations of the dependent claims. The Examiner again points to Applicant's arguments as "pointing out the shortcomings of a single reference." As already stated, the Applicant does not assert that the references individually fail to meet the present invention but that in fact, their combination is not taught or suggested. Applicant respectfully refers the Examiner to the points made in the previous Amendment in support of this position.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

Ronald Kimble Reg # 44,186 for

Alan J. Kasper
Registration No. 25,426

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: January 28, 2004